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66/975 7590 09/03/2009 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER CHENCINSKI, SIEGFRIED E				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/024,691

**Applicant(s)**

CABALLERO ET AL.

**Examiner**

SIEGFRIED E. CHENCINSKI

**Art Unit**

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**1. Claims 50-63 are rejected** because the claimed invention is directed to non-statutory subject matter. Independent claim 50 is not directed to any one of the areas of patentable subject matter, such as product, process, process of making or composition. Claims 51-63 are rejected because of their dependence on independent claim 50. For a claim to be statutory under 35 USC 101 the following condition must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result.

According to the above guidelines, Applicant's claims are limited to the manipulation of abstract ideas in the context of patentability because the claim lacks an indication of usefulness. The amended independent claims still do not result in an action but merely in a software program which does not meet the requirements of patentable subject matter, such as product, process, process of making or composition under 35 USC 101. Software does not represent a useful, concrete, tangible result under this statute.

**2. Claims 50-63 are rejected** because independent claim 50, a method claim, fails the transformation branch test of 35 USC 101. Claims 51-63 are rejected due to their dependence on independent claim 50.

The en banc decision by the federal Circuit court in *In re Bilski*, dated October 31, 2008 opined that transformation of a real object is required in a method claim. (The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain

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considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590.). In the instant claim only data is transformed. No real object is transformed. Certain steps, critical to the invention, are not claimed, such as the actual processing of an order. The object language in the claim represent computer programming code language, not a real object. Further, what is presented is the manipulation of data by a software system, so that the use of the computer, the machine, is merely trivial to the claimed purpose of the process. Software systems performing the same functions were copyrighted during the early 1990's or before and owned by such companies as Baan and SAS, and later Oracle, to name just a few of the largest providers.

**3. Claims 21 - 35 are rejected** because these dependent claims contain a combination of two statutory classes, namely a system and a process/method, thus making these claim statutorily indeterminate.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 4. Claims 51-63 are rejected** under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a clearly asserted utility or a well established utility for the reasons set forth above in the rejection of the claims under 35 USC 101, one skilled in the art clearly would not know how to use the claimed invention.
- 5. Claims 1-63 are rejected under 35 U.S.C. 112, first paragraph**, as based on a disclosure which is not enabling. A clear set of system and method steps leading to the

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processing of an order, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The lack of clarity is based on the conditional logic in the limitations of the independent claims and the lack of a potential result in a processed order. The dependent claims are rejected due to their dependence on the rejected independent claims.

Ambiguity is caused to a large extent due to the use of programming language instead of standard business language in the specification and the claims which the ordinary practitioner would use. This is exemplified by the last limitation in claim 50 which recites "transforming at least a portion of the business object into a complex object.". The specification fails to contain a clear definition of the expression "business object" and "complex object". The preamble leads one to expect that these steps relate to a processed order.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**6. Claims 1-63 are rejected under 35 U.S.C. 112, second paragraph**, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1, 19, 24, 36 and 50 fail to correspond in scope with that which applicant(s) regard as the invention can be found in the specification filed December 17, 2001. In that paper, applicant has stated the invention has the purpose of processing complex orders which include complex services and products, and this statement indicates that the invention is different from what is defined in the claim(s) because the independent claims do not include a limitation which indicates processing of orders. The three conditional choices provide options which do not lead to the processing of an order two out of three of the options.

**7. Claims 1-63 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. For example, the limitation "at least one business service method performs a function associated with the selected option" in independent method claim 50 is vague and indefinite. Independent claims 1, 19 and 36 contain similar enabling limitations (Claim 1 – "the at least one of the plurality of workflow processes is configured to invoke at least one of the plurality of business service methods to perform a function associated with the selected option."; Claim 19 – "generate a business object based on the portion of the service profile; and a transformation engine wherein the transformation engine is configured to generate at least a portion of the complex object, and the transformation engine is further configured to perform the generation using the business object."; Claim 36 – "the means for invoking the workflow process comprises a means for invoking at least one of the plurality of business service methods and the at least one of the plurality of business service methods is configured to perform a function associated with the selected option; means for receiving at least one of a service profile, quote information, and order information pertaining to an account from an external server; means for generating a business object").

**8. Claims 1-63 are rejected under 35 U.S.C. 112, second paragraph**, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are the steps needed to explicitly deliver the result of a processed order as stated in the preambles to the independent claims.

**9. Claims 1-63 are rejected under 35 U.S.C. 112, second paragraph**, because the metes and bounds in the claims are indefinite. For example, it is unclear what a complex object is and what a business object is. Again, the cause of this problem is because software programming language makes up the content of the claims.

**10. Claims 36 - 46 are rejected under 35 U.S.C. 112, second paragraph**, as failing the 112-6<sup>th</sup> paragraph test for means plus function claims. The claims, with independent claim 36 as exemplary, contain significant structure which modifies the means. This is not permitted by this statute because a "means for" is not permitted to be further defined in the claim. For example, the first means for limitation states "means for generating a

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customer portal” plus voluminous restrictions on the means embodied in the wherein statement modifying the “means for”. Every instance of such structure in any means for limitation in these claims fails the 112-6th test.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

### **11. EXAMINATION NOTES:**

a. Applicant's claims and the supporting specification are written in programming terminology (apparently using C++). Computer software is a matter of copyright, not patentability. Such application software has copyright protection and their use is sold and purchased under licensing agreements. Using independent method claim 50 as an example, the claims contain terminology such as “invoking a workflow process”, “generating a business object”, and “transforming at least a portion of the business object into a complex object” as the final result of method claim 50. Such terminology only speaks to the underlying software system but fails to add substance to the claimed limitations. The only exceptions are the preambles of the independent claims, which use more straight forward commonly understood business language, such as in claim 50,

"A method for processing orders comprising". However, most of the analogous prior art uses more commonly understood English expressions, leaving the programming out of the invention and stating that a number of programming languages can be used to construct the computer automating software. For examination purposes the examiner has the right and obligation to use equivalent language in order to search for and apply the prior art. This is what the examiner has done in prosecuting this application.

b. Use of programming terminology in the claims does not create patentable novelty, especially when other equivalent language is suitable and viable in defining a claimed limitation.

c. The examiner has searched the specification for clear definitions which an applicant has the right to make use of within reasonable limits to be his own lexicographer. However, the examiner has been unable to find such clear definitions which would make the claims terminology understandable to the ordinary practitioner attempting to make use of Applicant's invention and to help the examiner clearly understand the claimed inventions. This has made the examiner to make assumptions guided by the preambles to the independent claims.

d. Applicant's independent claims are written with numerous contingent options such that it is difficult to follow a single straight path to a concrete result (see the rejections under 35 USC 101 and 112). It seems true that this is supported by the specification, which may be the crux of the challenge in drafting claims which can pass statutory requirements.

e. The examination guidelines for rejections under 35 USC 103(a) are stated above and are amplified by case law which has been placed on the record in the first two Office Actions.

f. For prior art examination purposes, with independent method claim 50 as exemplary, the examiner has eliminated the conditional claim limitations to the following claim limitations:

50. (Original) A method for processing orders comprising:

- generating a customer portal, wherein the generating a customer portal comprises a list of products and services associated with an account,



- a list of quotes associated with the account,
- a list of orders associated with the account, and
- a plurality of user-selectable options, and
- presenting the customer portal such that the customer portal is accessible by a user, wherein the user is a customer,
- invoking a workflow process, wherein the workflow process invokes at least one business service method, and
- the at least one business service method performs a function associated with order information pertaining to an account;
- generating a business object, wherein the generating is based on the order information; and
- transforming at least a portion of the business object into a complex object.

**12. Claims 1-63 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Esposito et al. (US Patent 6,587,838 B1) in view of Wiecha (US Patent 5,870,717).

**Re. Claims 1, 19, 36 & 50,** Esposito discloses a method, system, apparatus, computer readable storage medium and data signal to enable users to interact with the system over heterogeneous network environments such as a packet switched network such as the Internet and a wireless network such as a plurality of pagers. At least one vendor computer is part of the system. The vendor computer has one or more databases for storing information about products and services in a product database, and a customer database, for storing information about customers. A plurality of client computers are part of the system. Esposito explicitly discloses that his system is driven by computer software (Col. 4, l. 52 - Col. 5, l. 21). The ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious that Esposito implies or suggests that the type of software used for such a system is not critical. The ordinary practitioner would also have known that most if not all business methods systems were able to be constructed through use of a wide variety systems designs and software code, systems designs and a variety of hardware configurations. It would also have been obvious to

the ordinary at the time of Applicant's invention that the compatibility problem between different computer systems, operating systems and applications software had been solved. The ordinary practitioner also would have known that specific narrow teachings were combinable and implementable for most if not all software/hardware combination systems due to the flexibility of computer programming. As such, such combinations do not have patentable novelty. Esposito's client computers enable users to interact with the system to learn about and express interest in products and services. Thus, Esposito explicitly and implicitly discloses the processing of complex sales prospect inquiries and the complex customer purchase orders (Abstract, ll. 1-6, 9-16). Esposito discloses generic customer portals (Fig's 1-7). Esposito does not explicitly describe the construction of the software for operating the vendor's system for processing complex customer inquiries and purchase orders, such as generating a customer portal, invoking a workflow process, receiving at least one of: a service profile, quote information pertaining to an account, generating a business object, and transforming at least a portion of the business object to a complex object. However, Wiecha discloses a computer-implemented method comprising: generating a list of accounts; selecting a selected account by detecting selection of one of the accounts, wherein the selecting a selected account is performed using a computer; generating a list of orders associated with the selected account, wherein the list of orders comprises orders that have been submitted to an external provisioning system for provisioning, and the computer and the external provisioning system are communicatively coupled to one another; selecting a selected order by detecting selection of one of the orders that has been submitted for provisioning by the external provisioning system, wherein the selecting a selected order is performed using the computer; detecting a request to make a change to the selected order, wherein the request comprises a change to the selected order; incorporating the change in the selected order; submitting a re-submitted order by submitting the selected order for provisioning by the external provisioning system; and, synchronizing the re-submitted order in the external provisioning system to override the one of the orders that had been submitted for provisioning.

The steps of generating a customer portal, a work flow process receiving of information from a customer pertaining to an account, the generating of a business object, and transforming a business object to a complex object would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention because they follow the logical order establishment steps disclosed, implied and suggested by Esposito, Wiecha and well known practices in the art of order placement and order acceptance. The work flow process and other systems design terminology in Applicant's claims limitations would have been understood by the ordinary practitioner as systems design and programming terminology. The only difference is the computer systems design terminology used by Applicant which represents systems design terminology for generic business manufacturing, since such systems have interacted with each other since the first materials computer systems into widespread use, led by Computer Associates' Ask ManMan system in the 1970's-1980's., increasingly displaced in the mid-1990's by Baan and SAP material management systems, among others, and eventually joined by Oracle's systems. The underlying software terminology such as objects appeared with these 1990's SAP and Baan systems. That terminology was objected to by users because it obscured the clear intuitive language needed by users to be efficient.. It would also have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that the terminology used in the following steps is computer systems terminology describing generic business practices which are well known in the art of purchasing and customer service: generating a customer portal comprising a list of products and services associated with an account, a list of quotes associated with the account, a list of orders associated with the account, and a plurality of user-selectable options, presenting the customer portal such that the customer portal is accessible by users including customer service representatives, customers, and service providers for the customers; invoking a workflow process, and the workflow process invokes at least one business service method to perform functions associated with a selected option from among the plurality of user-selectable options; receiving at least one of: a service profile, quote information, and order information pertaining to an account; generating a business object based on the at least one of: a service profile, quote information, and order

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information; and transforming at least a portion of the business object to a complex object.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices obvious to the ordinary practitioner in order to produce a method, system, apparatus, storage medium and data signal for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

**Re. Claims 2-18, 20-35, 37-49 and 51-63**, neither Esposito nor Wiecha explicitly disclose the computer system steps in these dependent claims. However, the steps represent generically obvious steps of the well known order placement and order acceptance process, mixed with special terminology created by Applicant and which is defined in the specification, such as "Apply Method", Delta Method, Trim Method and Logical Delete Method, which are some of the special terms found in claim 52. Examples of other well known steps are Supplemental Orders Process in claim 53, Move Process in claim 54, and various other steps which are ordinary to the traditional order placement and order acceptance process. These steps, usually with their own terminology labels, were well known to purchasing and customer service professional users at the time of Applicant's invention through the systems provided by many enterprise software suppliers, the best known of which were SAP, Baan and Oracle. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices in order to produce a method, system, apparatus, medium and data signal for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

### ***Response to Arguments***

13. Applicant's arguments filed June 16, 2009 with respect to claims 1-63 have been considered but are moot in view of the new ground(s) of rejection.

Applicant is further referred to the above clarifications of previous rejections and to the examiner's responses on the record to previously presented arguments.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on (571) 272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or Faxed to (571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

August 31, 2009

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3695